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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/387,443 09/01/99 KOPACIEWICZ

W 550P002CONT.

EXAMINER

IM52/0517

KEVIN S LEMACK
NIELDS LEMACK & DINGMAN
176 E MAIN STREET
SUITE 8
WESTBORO MA 01581

FORTUNA, A

ART UNIT

PAPER NUMBER

1723

DATE MAILED:

05/17/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

THE REQUEST FOR SUSPENSION OF ACTION UNDER 37 CFR 1.103 HAS BEEN APPROVED. THE SUSPENSION OF ACTION WILL TERMINATE 03 MONTHS AFTER DATE THE REQUEST FOR SUSPENSION OF ACTION WAS FILED.

Office Action Summary

Application No.

09/387,443

Applicant(s)

Kopaciewicz

Examiner

Ana Fortuna

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Apr 25, 2001
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) ☐ Other:

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DETAILED ACTION

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

2. (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
3. Claims 1, 2, 4, 5, 6, 9, 10, 11, 12, 14-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Mehl Ehrenfried et al (WO 98/08594 and EP 0 826, 412). Reference '594 discloses providing a microporous elements or membranes having adsorptive particles and provided at end of a tubular housing or pipette (abstract, pages 36-30, column 8, lines 1-31, column 14, lines 5-35, page 15, lines 1-30, column 17, lines 4-10, page 19, lines 7-32). The polymer having bound adsorptive particles provided continuous to the second open end of the housing or pipette is disclosed (Figures 1 and 4). Regarding claim 6, the polymer is disclosed as polystyrene, cellulose derivatives, etc.(page 3, lines 25-30). Reference '412 also discloses the pipette having the membrane with adsorptive particles at the tip or second end (Fig. 2), the membrane material, housing material and adsorptive particles and process for providing the membrane at the tip or end are disclosed (entire disclosure). Reference '412 further discloses the silica particles or adsorptive particles as treated or derivatized (column 4, lines 1-29).
4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 3, 7, 8, 13, 17, 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mehl Ehrenfried et al (WO 98/08594 and EP 0 826, 412) as applied to claims 2, 2, 4, 6, 9, 10, 11, 12, 14-16 above, and further in view of Kulprathipanja et al (5,127,925). Reference '594 and '412 disclose the housing or pipette made from polyolefin, e.g. polypropylene, but fails to disclose the polymer containing the adsorptive particles as polysulfone; hydrophobic polymers for the adsorptive particles containing membrane or filter medium is disclosed, e.g. polystyrene. Reference '925 discloses forming membrane with adsorptive particles and using polysulfone as the binder polymer, the particles are adoptive e.g. silica (abstract, column 5, lines 53-68, column 6, lines 1-4). Formation of membrane by solvent casting and or phase inversion is conventional in the art. Therefore, it would have been obvious to one skilled in the pertinent art to alternatively select conventional binders for adsorptive particles, e.g. polysulfone, as suggested by '925, for making a membrane containing the adsorptive properties, from the process disclosed by '494 or '412.

Regarding claims 3 and 13, the particular volume of the adsorptive structure or membrane is not disclosed, but immersing the pipette tip in the solution forming the structure or membrane by introducing into the tip 50 or more microliter of the solution, and further extracting the or

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solidifying the membrane in water bath is disclosed by '594 (page 45, 1-22). Therefore, a membrane having a volume in the order of microliter is expected to the skilled artisan.

Controlling the amount of solution inside the pipette tip will determined the volume of membrane having sorptive particles disposed in the pipette or housing, as suggested by the '594.

6. Response to arguments: the rejection over Koenst, Jr. has been withdrawn in response to applicant's arguments. The rejection over the EP(WO) reference is maintained. The Examiners agreed on the reference publication dates of the foreign applications, however, the filing date in these applications is earlier than the filing date of the provisional application in the present application, and goes back to 12/17/1996. A U.S. application claiming priority based on EP 0826412 A3 (filed on 12/17/1996) is currently pending before the Office, and may become a reference soon. By that time the rejection bases on the references above will be substitute by the corresponding US patent. Therefore, in order to give the Applicant an opportunity to amend the claims to avoid a rejection based on the disclosure of the U S patent, the prosecution on this case has not been resuspended, however, the action based on the references above has been maintained.

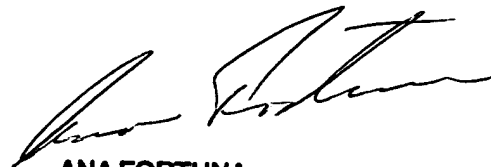
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ana Fortuna whose telephone number is (703) 308-3857.

Facsimile No (703)308-7718.

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A handwritten signature in black ink, appearing to read 'Ana Fortuna', is written above the printed name and title.

ANA FORTUNA
PRIMARY EXAMINER

Ana Fortuna

May 7, 2001